REMARKS

I. Status of Claims

Claims 1-36 and 41 are presently are pending, and claims 37-40 are withdrawn from consideration. All claims are rejected. Reconsideration is respectfull requested in view of the following remarks.

II. Double Patenting Rejection

Claims 1, 15-17, 23 and 27-36 are rejected under non-statutory obviousness-type double patenting grounds over claims 41-42, 45-51, 57-58, 62, and 73-75 of US Patent Application 11/780930. A terminal disclaimer is concurrently filed with this paper, accordingly, Applicants respectfully request that the Examiner withdraw the double patenting rejection.

III. Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner rejects claims 1, 17 and 21 under 35 U.S.C. § 112, first paragraph, questioning whether the limitation, "an inactive deposit account," which was added in the Amendment filed June 21, 2010. To the extent that the Examiner requires *ipsis verbis* support in the specification for the limitation, all that is required is "sufficient written description to inform a skilled artisan that applicant was in possession of the claimed invention as a whole at the time the application was filed."[1] As stated in the amendment, support for the inactive deposit account may be found *at least* at page 3, lines 1-11, which describes an exemplary embodiment wherein:

> The dead card is a bank card (e.g., an ATM card, checking card, debit card, or stored value card) not yet active, but which reflects and identifies **a bank account (e.g., checking account, savings account, loan account, stored value account, or sponsor-funded**

[1] M.P.E.P. § 2163(II)(3)(A)

> **stored value account) that will be activated** upon customer acceptance of the offer for a new bank account."[2]

Thus, the before the bank account is activated it is "inactive" as claimed. This inactive bank account could be a "past bank account" that was de-activated as indicated by the Examiner on Page 4 of the Office Action, as long as that past bank account is not active.

Further support may be found at page 12 lines 6 to 15, which describes creating a new bank account in anticipation of the customer deciding to open the new account:

> At 222, the bank may "prebuild" the new bank account, meaning that some or all of the records at the bank may be set up in anticipation of the customer deciding to open the new account corresponding to the dead bank card. Thus, the bank may establish the new account number for the bank and prepopulate such data fields as the customer's name, social security number, and so forth. According to one embodiment, the bank may prebuild the new bank account to the point where it is fully ready for activation without any or substantial further data entry. The beneficial feature of 222 is in harmony with one of the goals of providing the customer a dead bank card, which is to essentially make an offer for a new bank account that is "ready to go." Thus, the customer has a physical bank card ready for use, the bank has already set up the records for the new account, and so forth.

Accordingly, since one of ordinary skill in the art would have understand that the Applicant was in possession of the claimed invention at the time application was filed as evidenced by the specification as filed, and in particular, in possession of the claimed "inactive deposit account," the foregoing rejection under 35 U.S.C. § 112, first paragraph should be withdrawn.

III. Rejections Under 35 U.S.C. § 103

A. Claims 1-22 and 24-26

[2] Emphasis added.

Claims 1-22 and 24-26 stand rejected under 35 U.S.C. § 103 as allegedly rendered obvious by Melchione et al. (US Patent No. 5,930,764) in view of Walker et al. (US Pub. No. 2008/0052225) and further in view of Nabe et al. (US Patent No. 7,305,364). Applicants respectfully traverses the rejection of these claims as amended.

In response to the Applicants' argument in the response filed June 21, 2010, that Melchione and Walker, alone or in combination, do not teach or suggest, creating an unsolicited dead bank cards associated with an inactive deposit account and distributing those dead bank cards, the Examiner cites Walker's description of a dead credit card associated with a credit account, and Nabe's disclosure of generating customer leads using inactive customer loans.

First, Applicants once again submit that the Examiner is ignoring limitations of claims 1, 22, and 27, namely, that the claimed subject matter is directed to "dead bank cards" and "inactive deposit accounts." Walker describes a dead credit card associated with a credit account, not a dead bank card associated with an inactive deposit account. A credit/loan account is not a deposit account and they are not treated the same in the financial services industry. For example, and as explained on pages 8 to 10 of the specification as filed, if a credit card customer is outside the banking footprint of an issuing bank, it may not be feasible to provide a bank card and account.

Nabe fails to compensate for the deficiencies of Walker. Like Walker, Nabe is directed to credit/loan accounts, not deposit accounts. Nabe uses a database of Inactive Auto Finance Customers to find possible leads for a potential financier of a new car.[3] Using various marketing models (e.g., direct response model), Nabe selects a subset of former customers likely to

[3] Nabe, 8:63-15.

purchase a direct loan for a car. Thus, just as with Walker, Nabe is only directed to credit/loan accounts, not deposit accounts, and in any case, is unrelated to the claimed creating and distributing of an unsolicited dead bank card associated with an inactive deposit account. Thus, the Examiner has not considered the claimed invention as a whole but rather appears to be treating the claims as merely a laundry list of limitations.[4]

Regarding independent claim 17, for the reasons stated above Melchione in view of Walker and Nabe do not teach or suggest, "distributing a live credit card and an unsolicited dead bank card associated with an inactive deposit account to the customer if the application is approved and the customer is not an existing bank account holder." Applicants request that the Examiner withdraw the rejection of claim 17, and dependent claims 18-22 and 24-26.

B. Claims 27-32

Claims 27-32 stand rejected as allegedly rendered obvious by Jones et al. (US Pub. No. 2004/0117300) in view of Walker and further in view of Nabe.[5] Applicants respectfully traverse this rejection of the claims as amended.

The combination of Jones and Walker suffers from *at least* a similar deficiency as the combination of Melchione and Walker: neither reference teaches or suggests "distributing a live credit card and an unsolicited dead bank card associated with an inactive deposit account to the customer if the application is approved and the customer is not an existing bank account holder," as recited in claim 27. Jones is related to a payment card processing system that allows a

[4] M.P.E.P. § 2141.02(I).

[5] The Office Action indicates that the claims are rejected under 35 U.S.C. § 102(e), however since the rejection is presented in the form of a combination of three reference, Applicants assume that the Examiner meant that the references qualify as § 102(e) prior art, but the basis of the rejection is § 103(a).

payment card to be used on two different payment networks.[6] Jones describes utilizing a "dual card," which is, essentially, a single card that can be used a private label card and a bankcard, thus reducing the number of card a consumer has to carry.[7] Not surprisingly, part of the process is sending a user the "dual card."[8] When the dual card is distributed, it is associated with a live credit account, and a live bank account as evidenced by the fact that the user applies for opts into the dual card.[9] Thus, as with Melchione, the system in Jones must receive permission from a consumer before sending the card. As explained above, the claimed invention does not suffer from this limitation.

The Office Action recognizes the deficiencies of Jones, and instead cites Walker and Nabe. However, as described above, neither Walker nor Nabe teaches or suggests a dead bank card associated with an inactive deposit account. Thus, Applicants respectfully submit that claim 27 would not have been rendered obvious by Jones in view of Walker and Nabe because the references, alone or in combination, do not teach or suggest each and every limitation of the claims. Accordingly, Applicants request that the Examiner withdraw the rejection of claim 27, and claims 28-32 *at least* in view of their dependency from an allowable base claim.

C. Claim 23

Claim 23 stands rejected as allegedly rendered obvious by Melchione in view of Walker and further in view of Strock et al. (US Pub. No. 2004/0122736).[10] Applicants respectfully traverse this rejection.

---

[6] Jones, par. [0002].
[7] Jones, par. [0008], [0022].
[8] Jones, Fig. 5A.
[9] Jones, par. [0027]
[10] Page 13 of the Office Action indicates that claim 23 is rejected over Melchione in view of Strock, however, claim 13 is a dependent claim considered to include all of the limitations of claim 1, thus, any obviousness combination must include Walker.

First, Strock does not qualify as prior art. The present application was filed September 23, 2003. Strock was filed October 14, 2003, after the filing date of the present application. Thus, Strock is not prior art to the present application.

Further, as Strock relates to a system and method for providing promotional rewards, it clearly does not compensate for the deficiencies of Melchione and Walker with regard to independent claim 1. Accordingly, claim 23 is at least patentable by virtue of its dependency from claim 1, and Applicants respectfully request that the Examiner withdraw the rejection of this claim.

D. Claims 33-36

Claims 33 – 36 stand rejected as allegedly rendered obvious by Jones in view of Walker and further in view of Strock.[11] Applicants respectfully traverse this rejection.

For the reasons noted above, Jones, Walker and Strock do not teach or suggest all of the limitations of claim 27, thus, claims 33-36 are *at least* patentable by virtue of their dependency from claim 27. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of these claims.

[11] Page 15 of the Office Action indicates that claim 33-36 is rejected over Jones in view of Strock, however, claim 33-36 are dependent claim considered to include all of the limitations of claim 27, thus, any obviousness combination must include Walker.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Dated: September 16, 2010

Respectfully submitted,

Electronic signature: /Andrew J. Baca/
Andrew J. Baca
Registration No.: 60,887
GOODWIN PROCTER LLP
53 State Street
Boston, MA 02109
(617) 570-8261
Attorney for Applicant